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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,808	03/03/2000	Yoji Kawamoto	7217/31035	5769

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EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2443

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/518,808	Applicant(s) KAWAMOTO ET AL.	
	Examiner George C. Neurauter, Jr.	Art Unit 2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/12/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 and 10 are currently presented and have been examined.

Response to Arguments

Applicant's arguments with respect to claims 1 and 10 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 10 recite "said terminal device used by said user". There is insufficient antecedent basis for this limitation in the claim. The claims refer to a "plurality of different types of user terminal devices", but do not refer to any "user" being involved the use of the terminal device. Furthermore, the claims later recite a "terminal device currently being used by said user" and a "second terminal device currently being used by said user". It is unclear whether the "terminal device used by said user" is the same as the "terminal device currently being used by said user" or the "second terminal device currently being used by said user".

Claims 1 and 10 recite a "second terminal currently being used by said user". It is unclear whether the previous recitations of the "terminal device currently being used by said user" and its associated steps refer to the first or second terminal since the claims

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require that the user have at least two terminals being currently used and it is unclear which specific terminal device is being referred to within these steps.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6 697 836 B1 to Kawano et al in view of US Patent 5,261,052 to Shimamoto et al.

Regarding claim 1, Kawano discloses a network system connecting a plurality of different types of user terminal devices (referred to throughout the reference as “clients”) and a network server (“service mediate server”) via a known communication system, wherein each user terminal device comprises:

means for retrieving information from a removable memory (“IC card”; column 10, lines 33-38) loaded into the terminal device; said removable memory storing user specific information (“service requester information”) (column 10, lines 23-42), and

means for transmitting said user specific information and information identifying said terminal device (“client terminal information”) as specific information (“service request message”) when said removable memory is loaded, wherein said information identifying said terminal device includes terminal type attributes and media type attributes corresponding to said terminal device (“condition information” and “service interface”; column 5, lines 38-45; column 9, lines 35-47; see also Figure 3, element 1051c); (column 10, lines 23-42; column 11, lines 27-38) and

said network server comprises:

means for receiving said specific information transmitted by said terminal device used by said user, (column 11, lines 27-38)

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means for registering said user specific information and said information identifying said terminal device included in said specific information as registered information, (column 7, lines 21-31; column 8, lines 24-45; column 11, lines 33-38)

means for updating said registered information identifying said terminal device corresponding to said user specific information, (column 7, lines 32-65; column 11, lines 12-19)

means for identifying a latest type of terminal device, based on said updated information by said means for updating, currently being used by said user and for authenticating said user by referring to said registered information, (column 7, lines 32-65; column 11, lines 12-19 and 39-53)

means for notifying the authenticated user of the arrival of message information for the user when the removable memory is inserted into the terminal device, (column 5, lines 1-47, specifically lines 21-24; column 8, lines 33-45)

means for converting ("changing") message information addressed to said authenticated user to a data format compatible with said terminal device based on said terminal type attributes and said media type attributes of said terminal device currently being used by said user (column 2, lines 8-24; column 9, lines 25-47; column 11, line 54-column 12, line 14), and

means for transmitting the converted message information to said terminal device currently being used by said user, wherein, in response to said user requesting message information from the network server and switching from a first terminal device compatible with the first data format to a second terminal device compatible with the

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second data format before the requested message information is transmitted, the message information is converted from the first data format to the second data format and transmitted to the second terminal device. (Abstract, specifically “The information received by [a server] is processed by the service mediate agent and the processed information is transmitted to [a client].”; column 9, lines 25-47 and 59-64, specifically lines 59-64 wherein the service is “changed” according to the “environment of the system”) (see also column 5, lines 19-26, wherein terminal devices may be of different types and the terminal devices may be used “sharably by plural users” which suggests the users may switch between terminal devices and use the machines to retrieve the message information in the manner as described in the reference)

Kawano does not expressly disclose wherein the user specific information includes a group identification for identifying plural users of the user terminal device to form a specific group.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the nonfunctional descriptive material with the claimed invention because such data does not functionally relate to the steps in the

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method claimed and because the subjective interpretation of the descriptive material does not patentably distinguish the claimed invention.

Kawano also does not expressly disclose means for detecting an extraction of the removable memory from the terminal device based upon changes to an interface signal level from a logical high level to a logical low level and means for transmitting an erasure request to the network server based on the detected extraction of the removable memory and wherein the registered information is erased in response to the erasure request transmitted by the terminal device when said removable memory is extracted from the terminal device, however, Kawano does disclose the use of a memory means as a portable medium as shown above. Kawano also discloses wherein the memory means contains user specific information that uniquely identifies a user and contains information exclusive to the user and that information is registered at the network server at the time of memory means insertion (column 7, lines 21-31; column 8, lines 24-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to erase the registered information located at the network server when the memory means is extracted from the terminal device as disclosed in Kawano. Kawano discloses the memory means as a portable medium, which means that the user uses the memory means as a means to use his or her exclusive information to obtains service from a server for a temporary period of time. One of ordinary skill would recognize this fact and would have considered it obvious that the memory means would eventually be removed when the user no longer required the services of the server,

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causing the means which receives the memory means to go from a logical high level to a logical low level, thus signaling extraction. It would logically follow that the registered user's information would no longer be valid at the terminal at which the user used the memory means to obtain service from the server and the client would notify the server to that effect and the user's information would be considered invalid and, at some point in time, erased by an express deletion or by being overwritten by new values. To support this, Kawano disclosed that the use of memory means allows for the user to control his or her privacy and allow for the client that receives such a memory means to be in control of the reception of services (column 8, lines 33-45).

Kawano also did not expressly disclose, however, Shimamoto disclosed means for transmitting to the authenticated user message arrival data when the removable memory is inserted into the terminal device currently being used by the authenticated user, wherein the message arrival data indicates arrival at the network server of message information addressed to an electronic mail address of the authenticated user after the response to the erasure request by the network server, means for receiving a confirmation from the authenticated user requesting transmission, to the terminal device currently being used by the authenticated user, of the message information indicated by the message arrival data (see at least column 1, line 63-column 2, line 2, column 2, lines 16-25, column 6, lines 47-53, column 9, line 45-column 10, line 14, specifically column 10, lines 7-14)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since the teachings

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of Kawano and Shimamoto are analogous to one another regarding the use of removable memory and the delivery of the messages including electronic mail to a user that is authenticated by the use of a removable memory card and one of ordinary skill in the art would have been motivated to combine the teachings of these references based on this analogous relation. As disclosed in Shimamoto, the use of the removable memory allows the user to receive mail at any location (see column 2, lines 26-36). Therefore, one of ordinary skill would have been further motivated to combine the teachings of the references based on the disclosed advantages of using the teachings as taught in Shimamoto.

Claim 10 is also rejected since claim 10 recites a network system that contains substantially the same limitations as recited in claim 1.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571)272-3918. The examiner can normally be reached on the hours between 8:30am-5:00pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George C Neurauter, Jr./
Primary Examiner, Art Unit 2443